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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/143,232	08/28/1998	DAVID A. MONROE	067839.00700	3262

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BRACEWELL & PATTERSON  
SOUTH TOWER PENNZOIL PLACE  
711 LOUISIANA STREET  
SUITE 2900  
HOUSTON, TX 770022781

EXAMINER

CHIEU, PO LIN

ART UNIT

PAPER NUMBER

2615

DATE MAILED: 06/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/143,232

Applicant(s)

MONROE ET AL.

Examiner

Polin Chieu

Art Unit

2615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 March 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

1. Regarding the arguments to Nitardy (5,396,651), Kozuki et al teaches that it is common to record an audio signal with a video signal on a magnetic tape (col. 1, lines 23-64). Any desired audio source can be recorded. Further, it is common to record an audio and/or a video signal in an airplane so that the cause of an accident can be investigated by studying the recorded data.

2. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In the device of Kozuki et al the recording/reproduction device shown in figure 6 is related to a VCR or VTR. In a VCR or VTR, it is common to use a microprocessor (or a CPU) or the like to control the operations of the VCR. Further, in another embodiment Kozuki et al discloses such a controller in figure 10. The teachings of the additional embodiment shown in figure 10 make it obvious to have a CPU for controlling recording and playback.

***Claim Objections***

3. Claims 11-20 objected to because of the following informalities: in step e claims 11 and 17 recite "the display monitor"; however, there is no antecedent basis for a display monitor. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 5-6, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kozuki et al (6,069,994).

Regarding claim 1, Kozuki et al discloses a recorder/player (306), a video signal source for providing a video source (301), and a video signal transmission system (307-311) in figure 7. Kozuki et al also discloses a video signal switching system (305) responsive for selectively distributing the video signal to the recorder/player (306), the display monitor (not shown), and the transmission system (307-311), wherein a full motion video signal may be distributed to the recorder/player (306) while a selected still frame of the video signal is distributed to other components (313) of the system (col. 2, lines 14-19). Kozuki et al does not disclose a video signal display monitor or a central processing unit (CPU) for controlling the recording/playback system.

Kozuki et al teaches a CPU (115) controlling a recording/reproducing device in figure 10 and a display (143) in figure 15. Many electronic devices, such as VCRs, use CPUs to control recording and playback. A display would have to be connected to the output of the embodiment (311) shown in figure 7 to view to video signal.

It would have been highly desirable to have a video signal display monitor so that the images could be viewed. It would have been highly desirable to have a CPU to generate control signals that control the functions of the device.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have a video signal display monitor in Kozuki et al.

Regarding claim 2, Kozuki et al discloses a digital capture system for creating a still frame on the fly as the full motion video signal is generated by the video signal source (col. 1, line 65 to col. 2, line 13). Kozuki et al also discloses recording a full field still frame (col. 2, line 9).

Regarding claim 3, Kozuki et al discloses a means for capturing a selected group of sequential still frames on the fly as the full motion video signal is generated by the video signal source (col. 3, lines 10-20).

Regarding claim 5, Kozuki et al discloses an audio signal generator for generating an audio signal (col. 1, lines 1-65). It is well known in the art that an audio signal can be recorded by the recorder/player in real time synchronization with the full motion video signal. Further synchronizing audio and video is common practice in VTRs.

In claim 6 the data signal can be interpreted as an audio signal. Please refer to the art rejection of claim 5.

The limitations of claim 11 are similar to claim 1 without the display monitor. Claim 11 additionally recites an audio signal source. Kozuki et al does not disclose audio signal source in the embodiment shown in figure 7.

Kozuki et al teaches recording an audio signal (col. 1, lines 36-64). Clearly the audio signal must have a source such as a microphone.

It would have been highly desirable to have an audio signal source for recording so that the device can record audio with the video.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have an audio signal source in the device of Kozuki et al.

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kozuki et al in view of Krause et al (6,304,714).

Regarding claim 4, Kozuki et al discloses a first mode for transmitting full motion video (discussed in claim 1) and second mode for transmitting full motion video signals as a playback of the recorded full motion video signal from the recorder/player (col. 7, line 39 to col. 8, line 4). However, Kozuki et al does not disclose transmitting full motion video in a first mode as the full motion video is generated by the video signal source.

Krause et al teaches simultaneous recording and reproduction (col. 10, lines 41-52). This would allow Kozuki et al to receive (and record) a video signal while a signal is being transmitted to an output device (display).

It would have been highly desirable to transmit a signal while receiving a signal so that a user could watch any portion of the recorded video while the signal is recording (unlike conventional VCRs).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to transmit a signal while receiving the signal in the device of Kozuki et al.

7. Claims 7, 13-15, 17-18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kozuki et al in view of Cooper (5,508,736).

Regarding claim 7, Kozuki et al does not disclose a GPS signal generator.

Cooper discloses a GPS signal generator (col. 4, lines 1-32).

It would have been highly desirable to have GPS signal generator so that a person or vehicle's position can be located from the signal.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have a GPS signal generator in Kozuki et al.

Regarding claim 13-15, Kozuki et al does not disclose a data signal source for recording comprising a GPS receiver and an encryption unit for encrypting a signal.

Cooper teaches a data signal source comprising position data (col. 4, lines 5-49) and an encryption unit 13 in figure 1.

Cooper teaches that it would have been highly desirable to have a data signal source so that comments can be recorded with navigational data (col. 4, lines 33-49). It would have been highly desirable to encrypt the data so that only people with the proper codes to decrypt the data would be able to view it.

Therefore, it would have been highly desirable to a person of ordinary skill in the art at the time of the invention to have a data signal source comprising a GPS receiver and an encryption unit in the device of Kozuki et al.

Claims 17, 18, and 20 combine the limitations of claims 11, 13, 14, and 15.  
Please refer to the art rejection of claims 11, 13, 14, and 15.

8. Claims 8, 9, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kozuki et al in view of Fujita et al (5,974,219).

Regarding claims 8 and 16, Kozuki et al does not disclose a marking signal generator.

Fujita et al discloses a marking signal generator (201) for selecting still frames of the recorded full motion video to be marked (col. 9, lines 60-65) in figure 1. Fujita et al also discloses that the system is adapted to select said frames by searching for the marks in figure 12, for distribution of the recorded marked frames.

It would have been highly desirable to have a marking signal generator so that a portion of full motion video can be quickly identified and distributed for editing purposes.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention have a marking signal generator in Kozuki et al.

Regarding claim 9, Kozuki et al does not disclose a marking signal generator with two modes.

Fujita et al discloses a first mode being manually activated by an operator (col. 3, lines 25-30), and a second mode being activated by a preselected data signal (col. 3, lines 30-40).



It would have been highly desirable to have two modes so that the user could select marking points or the device would automatically select marking points.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have two modes for the marking signal generator in Kozuki et al.

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kozuki et al in view of Freeman (5,684,716).

Kozuki et al does not disclose that the central processing unit is a Pentium class processor.

Freeman discloses a video transmission device using a PC (col. 2, lines 60-65).

It is well known in the art that PCs often use Pentium class processors. It would have been highly desirable to have a PC, which could have a Pentium class processor, so that a video signal can be transmitted to a host unit by cellular phone (col. 4, lines 10-30).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have a Pentium class processor in Kozuki et al.

10. Claims 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kozuki et al in view of Nitardy (5,396,651).

Kozuki et al does not disclose that the audio signal source comprises an aircraft interphone.

Nitardy teaches the use of an aircraft interphone (col. 3, lines 5-35).

It would have been highly desirable to have the audio signal source comprise an aircraft interphone so that the communications between the aircraft and another aircraft can be recorded. In a plane crash, these recordings may allow investigators to determine the cause of the crash.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have an aircraft interphone in the device of Kozuki et al.

11. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kozuki et al in view of Cooper and Nitardy.

Claim 19 recites the limitations discussed in the art rejection of claim 12. Please refer to the art rejection of claim 12.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lee (5,742,336) discloses a mean for recording audio and video signals from a plane.

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Polin Chieu whose telephone number is (703) 308-6070. The examiner can normally be reached on M-F 8:30 AM-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew B. Christensen can be reached on (703) 308-9644. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

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PC  
May 22, 2002

A handwritten signature in black ink, appearing to read 'A. Christensen', with a long horizontal flourish extending to the right.

ANDREW CHRISTENSEN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600